

**REMARKS / ARGUMENTS**

This Amendment is being filed in response to the Office Action dated September 26, 2008. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 17-32 are pending in the Application. Claims 1-16 are canceled herein, without prejudice. The Applicants respectfully reserve the right to reintroduce subject matter deleted herein, either at a later time during the prosecution of this application or any continuing applications. Claims 17-32 are added by this amendment to present claims that better conform to U.S. practice. It is respectfully submitted that the claims are not amended to address issues of patentability and Applicants respectfully reserve all rights under the Doctrine of Equivalents.

Applicants thank the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority document(s), as well as acceptance of the drawings filed on April 10, 2006.

In the Office Action, claims 2, 3, 6, 7, 12, 13, 15 and 16 are objected to for having "awkward wording." It is respectfully submitted that the cancellation of claims 1-16 renders this objection to the claims moot. The new claims are provided in proper U.S. form. Accordingly, withdrawal of the claim objections is respectfully requested.

In the Office Action, claims 1-16 are rejected under 35 U.S.C.

§112, second paragraph, as allegedly being indefinite. It is respectfully submitted that the cancellation of claims 1-16 renders this rejection to the claims moot. The new claims are provided in proper U.S. form including proper antecedence when appropriate. Accordingly, withdrawal of the rejection under U.S.C. §112, second paragraph is respectfully requested.

In the Office Action, claims 1-7 and 14-16 are rejected under 35 U.S.C. 101 as allegedly directed to non-statutory matter. It is respectfully submitted that the cancellation of claims 1-16 renders this rejection to the claims moot. The new claims are provided directed to statutory subject matter. With regard to the comments provided in the Office Action directed to optical disks, the Office Action contends, in general, that "optical disks" are not a process, machine, manufacture, nor a composition of matter. Moreover, with regard to the comments provided in the Office Action directed to the optical disk player, the Office Action contends that "an optical disk player" as claimed does not explicitly recite "physical components" and such components may be purely software. Applicants respectfully disagree with and traverse these rejections.

First of all, an optical disk is clearly an "article of manufacture" which falls within one of the statutory classes of subject matter under 35 U.S.C. §101. Moreover, it is respectfully submitted that an optical disk player cannot be solely implemented via software, as it is extremely well known and understood by those

of ordinary skill in the art that a "read-out" means of an optical disk player includes at least an optical pick-up device for reading/writing information from/to a disc.

Notwithstanding the above, in the interest of advancing prosecution, new claims are provided in better form and for clarification of the claimed subject matter. Accordingly, withdrawal of the rejection under 35 U.S.C. 101 is respectfully requested.

In the Office Action, claims 1, 2, 4, 8 and 14-16 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,470,085 to Uranaka ("Uranaka"). Claim 3 is rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Uranaka in view of U.S. Patent No. 5,754,648 to Ryan ("Ryan"). Claims 5 and 9-11 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Uranaka in view of U.S. Patent Publication No. 2002/0073316 to Collins ("Collins"). Claims 6 and 12 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Uranaka in view of U.S. Patent Publication No. 2003/0195855 to Parks ("Parks"). Claims 7 and 13 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Uranaka in view of Parks and further in view of Sun Microsystems, "The Java™ Language: An Overview", pp. 1-7, 1995 ("Sun").

It is respectfully submitted that the cancellation of claims 1-16 renders these rejections to the claims moot. Nonetheless, in the interest of advancing consideration and allowance of the

pending claims, the Applicant's provide below a discussion of the cited prior art. It is respectfully submitted that claims 17-32 are allowable over Uranaka alone and in view of any combination of Ryan, Collins, Parks and Sun for at least the following reasons.

Uranaka shows a system for controlling user access to applications recorded on a DVD based on terms of use (TOU) and control data/programs contained on the DVD. Uranaka shows in FIG. 2 an application package 20 recorded on a DVD 3, which includes an application 21 and a distribution descriptor 23. Uranaka shows in FIG. 4 that the distribution descriptor 23 includes, e.g., a server public key (PKs) 31 and a PKu-encrypted application-encrypting key (Kv) 32 (user-public-key). The PKs 31 is used to encrypt each stored application 21 in the package 20 (see, Col. 5, line 20 through Col. 6, lines 5).

Uranaka shows that a stored application can be accessed using a secret key SKu of the user (which corresponds to the user's public key PKu) to decrypt the user's public key-encrypted, encryption key Kv. The decrypted encryption key Kv may after decryption, be used to decrypt a stored application on the DVD. (See, Col. 11, lines 14-30.) Uranaka shows in FIG. 20C a process in which the application encrypting key Kv can be obtained from the server (8) in a process that allows a user to test the signature of the server (8) for server authentication using the server public key PKs stored on the DVD. (See, Col. 15, lines 56-60.)

In view of the above, it is respectfully submitted that the

optical disk of claim 1 is not anticipated or made obvious by the teachings of Uranaka. For example, Uranaka does not disclose or suggest, an optical disk that amongst other patentable elements, comprises (illustrative emphasis added) "stored media content that is played in coordination with downloadable content associated with the stored media content; and a public key which is used by the optical disk playing system to verify the authenticity of the downloadable content before the downloadable content is played in coordination with the associated stored media content" as recited in claim 17, and as similarly claimed in claims 20, 25 and 32.

Indeed, as shown above, although Uranaka discloses a public key PKs (element 31, FIG. 4) stored on a DVD, Uranaka teaches that the server public key is used to encrypt the stored applications on the DVD and to authenticate a signature by the server. However, Uranaka does not disclose or suggest a public key used to verify the authenticity of downloaded content that is associated with, and played in coordination with, stored media content on the DVD.

The Office Action repeatedly cites Col. 15, lines 57-67 of Uranaka as disclosing "verifying whether downloaded content is authentic", but it is respectfully asserted that reliance on Uranaka in this regard is misplaced. Indeed, as noted above, the cited section of Uranaka merely discloses a process of a server digitally signing a double encrypted application-encryption key Kv to be sent to the client DVD system, whereby the client system can "authenticate" the server by testing the digital signature using

the server public key PKs stored on the DVD. The process of authenticating a server is not the same as authenticating downloaded content within the context of the claimed inventions.

Each of Ryan, Collins, Parks and Sun are introduced for allegedly showing elements of the dependent claims and as such, do nothing to cure the deficiencies in Uranaka.

Based on the foregoing, the Applicants respectfully submit that independent claims 17, 20, 25 and 32 are patentable over Uranaka and notice to this effect is earnestly solicited. Claims 18-19, 21-24 and 26-31 respectively depend from one of claims 17, 20 and 25 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

By /Gregory L. Thorne/

Gregory L. Thorne, Reg. 39,398  
Attorney for Applicant(s)  
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**THORNE & HALAJIAN, LLP**  
Applied Technology Center  
111 West Main Street  
Bay Shore, NY 11706  
Tel: (631) 665-5139  
Fax: (631) 665-5101